

II. Remarks

Claims 1, 3, 8-18, 20 and 22-44 are pending and rejected. Applicants sincerely thank Examiner Lang for the telephonic interview conducted on July 27, 2009, which resulted in the supplemental Final Office Action. Based on discussions during the case interview, and by this paper, claims 10, 12, 13, 16, 18, 22-24, 27, 34, 37, and 40 have been amended and claims 14, 15, and 17 have been canceled. With the amendments and remarks provided herewith, Applicants respectfully request reconsideration and withdrawal of all rejections. Support for the above amendments is found in Applicants' specification as originally filed.

In the Drawings

Responsive to the objection to the drawings for failure to show the filter comprising at least one attachment wire that extends through the lumen of the plurality of divergent legs, a Replacement Sheet, including amendments to Fig. 16 to correct the misnumbering of the filter part, filter legs, and lumens, is being attached herewith. More specifically, the reference numeral indicating the filter part has been changed from 200' to 300'; the reference numerals indicating the filter legs have been changed from 510'-540' to 310'-340'; and the reference numerals indicating the filter leg lumens have been changed from 510d, 520d, 530d, and 540d to 310d, 320d, 330d, and 340d, respectively. Thus, Fig. 16 illustrates a filter comprising at least one attachment wire 521' that extends through the lumen 310d-340d of the plurality of divergent legs 310'-340'. Support for these amendments is found in paragraph [0063] of Applicants' specification as originally filed. Thus, no new matter has been added.

Further responsive to the objection to the drawings for failure to show the attachment wire attached to the second attachment member, Fig. 16 illustrates only one form of the filter part 300' having an attachment member including an attachment wire and Figs. 6-7 and 9-13 illustrate various forms of the invention in which the attachment wire is attached to the second attachment member. Moreover, the claims recite that the first and second attachment members are "attachable to one another to releasably attach the filter to the stent." Thus, the embodiment illustrated and described with respect to Fig. 16, in conjunction with those illustrated and described with respect to Figs. 6-7 and 9-13, is sufficient to facilitate to one of

ordinary skill in the art an understanding of the invention in accordance with the requirements under 35 U.S.C. § 113 and 37 C.F.R. § 1.81. Accordingly, Applicants respectfully request withdrawal of these objections.

Rejections Under 35 U.S.C. § 112

Responsive to the rejections of claims 16 and 34 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, claims 16 and 34 have been amended to overcome the insufficient antecedent basis rejections with respect to the limitation “the locking mechanism.” More specifically, claim 16 has been amended to recite that “at least one of the first attachment member and the second attachment member is configured to avoid contact with the tubular vessel” and claim 34 has been amended to recite that “at least one of the first attachment member and the second attachment member further comprises a coiled attachment member.” There is sufficient antecedent basis for “the first attachment member and the second attachment member” in claim 1 from which claims 16 and 34 depend.

Responsive to the rejections of claims 10, 14, 15, 17, 22-24, and 37 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, claims 14, 15, and 17 have been canceled and claims 10, 22-24, and 37 have been amended to overcome the insufficient antecedent basis rejections with respect to the limitation “filter attachment means and stent attachment means.” More specifically, claims 10, 22-24, and 37 have been amended to recite the limitations “first attachment member” and “second attachment member,” for which there is sufficient antecedent basis in claim 1, from which claims 10, 22-24, and 37 generally depend.

Responsive to the rejection of claim 40 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, claim 40 has been amended to recite that the at least one attachment wire is “attached to a retrieval connection member,” examples of which are shown and described with respect to Figs. 6 and 16-18. See, e.g., paragraphs [0063]-[0064] of Applicants’ specification as originally filed.

For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. § 112, paragraph 2.

Rejections Under 35 U.S.C. § 102

Responsive to the rejections of claims 1, 3, 8-17, 20, 22-26, and 36 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,712,834 to Yassour et al. ("Yassour"), Yassour fails to teach each and every element as set forth in the invention as claimed in independent claim 1. For example, claim 1 recites a filter having "a plurality of divergent legs," and "a first attachment member separate from, but attached to the second end of at least one of the plurality of divergent legs." Claim 1 further recites a stent and "a second attachment member separate from, but attached to the stent, the first and second attachment members being separate from, but attachable to one another to releasably attach the filter to the stent."

Contrarily, Yassour teaches a "thimble-like metallic net" filtering unit 100 with "laterally projecting hooks." One of ordinary skill in the art would appreciate the distinction between "a plurality of divergent legs" recited in claim 1 and shown and described in Applicants' specification and the woven metallic net or mesh disclosed in Yassour. This distinction is supported by Yassour's use of the different terms "metallic net," used to describe the filtering unit 52, and "connecting legs 54," used to describe the legs connecting the filtering unit 52 to the anchoring member 56 in Fig. 2A. Yassour, col. 7, lines 14-19. Moreover, "divergent" is defined in Merriam-Webster's online Dictionary as "to go or move in different directions from a central point; see SEPARATE." See <http://www.merriam-webster.com/thesaurus/diverge>. During the case interview, the Examiner stated that the asserted "legs" in Yassour are divergent since they move outward from trap element 206. The filtering unit of Yassour, however, is "made of fine wire woven into a net having a mesh." (See col. 7, lines 13-15). Thus, the fine wires do not "diverge" or "separate;" rather, they extend in a direction towards one another in order to interweave. Thus, Yassour fails to teach a filter having "a plurality of divergent legs."

Moreover, Yassour fails to teach "a second attachment member separate from, but attached to the stent." The Examiner uses the narrowed portion of the stent to teach the second attachment member, asserting that it is "separate from the stent since it comprises a different region with a distinct diameter and a separate

function.” See Office Action, page 4. Applicants respectfully traverse this assertion. The narrowed portion of the stent is still a unitary part of the stent. It is not “separate from, but attached to the stent” as recited in claim 1. Such an assertion is analogous to stating that the wider portion of the filter of Applicants’ invention is “separate from, but attached to” the narrower portion of the filter. However, the stent in *Yassour*, like Applicants’ filter, is clearly one element. Regardless of the fact that it may have portions with different dimensions, there is no reasoning, whatsoever, to support an assertion that the narrowed portion of the stent is an “attachment member separate from, but attached to the stent.” The narrowed portion of the stent is clearly still the stent, not an attachment member “separate from, but attached to” the stent.

Accordingly, *Yassour* does not teach each and every element of claim 1. Claims 3, 8-17, 20, 22-26, and 36 depend generally from claim 1. Thus, claims 3, 8-17, 20, 22-26, and 36 are allowable for at least the reasons provided above.

Rejections Under 35 U.S.C. § 103

Responsive to the rejections of claims 18, 27-35, and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over *Yassour*, claims 18, 27-35, and 37-39 depend generally from claim 1 and *Yassour* fails to teach or suggest each and every element recited in claim 1 for at least the reasons provided above. Thus, claims 18, 27-35, and 37-39 are allowable for at least the reasons provided above.

Responsive to the rejections of claims 23 and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Yassour* in view of U.S. Patent No. 6,342,063 to DeVries et al. (“*DeVries*”), the combination of these references fails to render these claims unpatentable because these references, even in combination, fail to teach each and every element of the claimed invention. Claim 23 generally depends from claim 1, and claim 40 includes the limitations recited in claim 1 as mentioned above. Thus, *Yassour* fails to teach or suggest each and every element of claims 23 and 40 for at least the reasons provided above with respect to claim 1 and *DeVries* fails to cure the deficiencies of *Yassour*.

Moreover, claim 40 additionally recites “at least one attachment wire [which] extends through at least one lumen of the plurality of divergent legs and is attached to a retrieval connection member.” The Examiner acknowledges that *Yassour* fails to disclose an attachment wire extending through the lumen of the filter legs and

combines *DeVries* with *Yassour* to teach such limitation. Even if, for the sake of argument, *DeVries* taught a filter leg having an attachment wire disposed within a lumen thereof and attached to a retrieval connection member, combining *DeVries* with *Yassour* to teach such limitations is improper. As provided above, the filtering unit in *Yassour* is made of "fine wire woven into a net." There is no reason to provide a lumen, with an attachment wire disposed within, through such fine, woven wires. "It can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

Responsive to the rejection of claim 44 under 35 U.S.C. § 103(a) as being unpatentable over *Yassour* in view of U.S. Patent Pub. No. 2002/0116024, to Goldberg et al. ("*Goldberg*"), the combination of these references fails to render these claims unpatentable because these references, even in combination, fail to teach each and every element of the claimed invention. Claim 44 includes the limitations recited in claim 1 as mentioned above. Thus, *Yassour* fails to teach or suggest each and every element of claim 44 for at least the reasons provided above with respect to claim 1 and *Goldberg* fails to cure the deficiencies of *Yassour*.

Thus, any combination of these references fails to teach or suggest each and every element of the invention as claimed in independent claims 40 and 44

Conclusion

Thus, the Applicants believe that claims 1, 3, 8-13, 16, 18, 20 and 22-44 are in a condition for allowance and such action is respectfully requested.

Respectfully submitted,

October 2, 2009

Date

/Katie B. Goedertier/

Katie B. Goedertier (Reg. No. 63,409)